

### **REMARKS**

Claims 1-8 are pending in this application. Claims 1, 3 and 7 are independent claims.

By this amendment, claim 7 is amended, and new claim 8 is added. Claims 1 and 2 are withdrawn from consideration.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

#### **The Claims Define Patentable Subject Matter**

The Office Action makes the following rejections:

(1) claim 7 is rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,873,207; and

(2) claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,355,096 to Kobayashi.

These rejections are respectfully traversed.

#### **Double Patenting Rejection**

Regarding the Double Patenting rejection, the Examiner is alleging that claim 7 only specifies “intended use” of the invention which is not given any patentable weight as they do not materially affect the final product claimed. Applicant respectfully disagrees with this allegation.

For example, the Examiner alleges that both the preamble phrase “a communication device” and the last phrase in the claim “the power amplification circuit is a transmitting section” are intended use phrases which carry no patentable weight because they do not materially affect the final product claimed. Applicant submits that such phrases can and do indeed carry patentable weight in this case.

For instance, regarding the preamble phrase “a communication device”, the determination of whether preamble recitations are structural limitations can be resolved only on a review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). In this case, applicant submits that the

claim preamble gives life and meaning to the claim, and thus properly defines the claimed invention. As such, applicant submits that the recitation “a communication device” should not be simply ignored.

Furthermore, regarding the last phrase of claim 7, applicant respectfully points out that the determination of whether such a wherein clause is a limitation depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “...‘whereby’ (or wherein) clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.”

Applicant submits that the last phrase in claim 7, i.e., wherein the power amplification circuit is a transmitting section, states a condition of the communication device that is material to patentability. As such, such a phrase cannot be simply ignored.

With the above in mind, applicant submits that the Examiner is improperly ignoring various phrases in claim 7.

However, although applicant believes that such a conduct by the Examiner is improper, in order to expedite prosecution applicant is amending claim 7 to more positively recite such features.

For example, claim 7 is amended so as to more positively recite a communication device in the body of claim 7 and how the transmitting section relates thereto.

Accordingly, withdrawal of the Double Patenting rejection to claim 7 is respectfully requested.

#### Rejections under 35 U.S.C. §103(a)

Applicant respectfully submits that the claimed invention is distinguishable from Kobayashi for at least the following reasons:

The Examiner alleges that Kobayashi discloses a negative feedback circuit connected between a power signal input terminal (46) and a power signal output terminal (48). (see Office Action, page 3). Applicant respectfully disagrees with this allegation.

For instance, applicant submits that the Examiner appears to be misreading Fig. 3 of Kobayashi. For example, the power signal input terminal (46) of Kobayashi is not connected to

the alleged negative feedback circuit (including diode (100) and capacitance device (92/94)). Instead, the power signal input terminal (46) goes directly to the base of transistor (64). As such, Kobayashi's alleged negative feedback circuit consisting of diode (100) and capacitance devices (92/94) fail to be connected between a power signal input terminal and a power signal output terminal of the power amplifier.

Furthermore, even if Kobayashi's alleged negative feedback circuit was connected between a power signal input and output of the power amplifier, the diode 100 of the negative feedback circuit 28 in Figure 3 of Kobayashi is merely DC-biased in terms of direct current by a biasing resistor 98 and a tuning voltage source. In contrast with the present invention, according to claim 7 the diode is not DC-biased because one end of the diode is opened by a capacitor. Therefore, the diode of claim 7 is in an off state in view of direct current. Furthermore, a direct current fails to flow through the diode in claim 7 so that the bias state of the power amplification transistor is not disturbed. Kobayashi clearly fails to teach or suggest such features.

Furthermore, as mentioned above, the Examiner alleges that both the preamble phrase "a communication device" and the last phrase in the claim "the power amplification circuit is a transmitting section" are intended use phrases which carry no patentable weight because they do not materially affect the final product claimed. As such, the Examiner has failed to apply any prior art to such features. Applicant submits that this is improper. Further, applicant submits that the claim amendment to claim 7 highlights such features that are clearly absent in Kobayashi.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that the examiner has failed to establish a *prima facie* case of obviousness at least in part because the examiner has failed to show how each and every feature is taught by the cited art. Applicant respectfully submits that independent claim 7 is allowable over Kobayashi for at least the reasons noted above. Additionally, new claim 8 is also allowable over Kobayashi for similar reasons.

Accordingly, withdrawal of the rejection of claim 7 under 35 U.S.C. §103(a) is respectfully requested.

### Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview.**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

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Respectfully submitted,

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